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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/775,425	02/01/2001	Lee A. Chase	LII153B US	7026

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EXAMINER
STORMER, RUSSELL D

ART UNIT	PAPER NUMBER
3617	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/775,425	Applicant(s) Chase et al
	Examiner Russell D. Stormer	Art Unit 3617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *9 Aug 2002*.

2a) ☒ This action is **FINAL.** 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-6, 8-11, 13-20, 22-25, 27, and 28* is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-6, 8-11, 13-20, 22-25, 27, and 28* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
4) ☐ Interview Summary (PTO-413) Paper No(s). _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

Specification

1. Given Applicants' statement that the term "net" is common in the wheel covering industry, all objections to this term have been overcome.

2. It should be noted that Applicants' allegations that the Examiner has objected to the use of the term in one instance and indicated that another use of the term on the same page was appropriate are totally without basis. See the second paragraph of page 6 of the response filed August 9, 2002. Nowhere in the office action dated May 10, 2002 is such a statement found. Applicants' motivations in making such a false statement are not clear, but a fabricated allegation such as this does not help to advance the prosecution of the application.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

4. Claims 1, 10, and 11 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Todd.

As shown in figures 2 and 4b the peripheral lip 34 of the overlay substantially covers the flange lip of the rim but does not extend beyond the outermost edge of the flange lip of the rim. See lines 35 and 36 of column 3 of Todd.

There is no reason to believe that the peripheral lip of the overlay would be able to extend beyond the outermost edge of the flange lip because it is shown and described as extending *to* the edge of the wheel. Further, it is not described as being able to extend beyond the edge of the wheel so one cannot assume that is could extend beyond the edge of the wheel.

5. Claims 1, 4, 5, 8, 10, and 11 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Eikhoff.

As shown in both figures 4 and 5, the overlay includes a peripheral lip 54 which substantially covers, but does not extend beyond, the outermost edge (periphery) of the rim flange lip. Lines 44-67 of column 3 describe the flange or lip portion 54 as extending over the peripheral edge of the term 16 to the side 23 as shown in figure 5, or alternatively extending over the top of the rim flange to encase the rim flange as shown in figure 4. Clearly, the embodiment of the flange 54 shown in figure 5 does not and cannot extend radially beyond the outermost edge of the flange lip of the rim of the wheel. There is no reason to believe that the embodiment of the flange 54 shown in figure 5 would or could extend beyond the outermost edge of the flange lip of the rim since the patent specifically teaches that the flange 54 in figure 5 does not, and further specifically teaches other embodiments that do.

6. Claims 1, 10, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Buerger.

As shown in figures 3 and 4, the wheel cover includes an outermost peripheral lip which substantially covers, but not extend beyond, the outermost edge of the rim flange. The peripheral lip 32 is described as overlying the rim 18 at its major diameter. See lines 25 and 26 of column 4 of Buerger. The lip 32 is *not* described as being capable of extending beyond the diameter of the lip of the rim 18 and it must therefore be assumed that it could not do so.

7. Claims 1, 4, 5, 10, 11, 15, 18, 19, 20, 24, and 25 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Beam 5,368,370 (newly applied).

The lip 48 of the overlay cannot extend radially beyond the outermost edge of the flange lip of the wheel rim as shown in figure 5.

8. Claims 1, 4, 5, 6, 11, 15, 18, 19, 20, and 25 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Maloney et al 5,435,631 (newly applied).

The peripheral lip 68 of the overlay cannot extend radially beyond the outermost edge 54 of the rim flange.

9. Claims 1, 4, 6, 8, 11, 13, 14, 15, 18, 20, 22, 25, 27, and 28 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Chase et al 5,564,791 (newly applied).

The peripheral lip 122a of the overlay cannot extend radially beyond the outermost edge 120 of the rim flange as shown in figures 2, 4, and 5.

10. Claims 1, 2, 3, 9, 11, 15, 16, 17, 23, and 25 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Murray et al 5,842,750 (newly applied).

The peripheral lip 13 of the overlay cannot extend beyond the outermost edge of the rim flange as shown in figure 3. The overlay material is molded to the wheel such that the lip 13 extends to the edge of the rim flange, but not beyond it. Further, the material can be trimmed to size if necessary.

With respect to claims 2 and 3, since the material of the overlay extends to the very edge of the rim flange, it would inherently be aligned with the radially outermost edge of the rim flange within a margin of 1.2 to 1.5 millimeters, within a margin of zero millimeters with a tolerance of 1.6 millimeters.

With respect to claims 9 and 23 the paint finish would have to be heat-resistant in order to used on the overlay so that it could withstand the heat generated by the brakes that gets transmitted to the wheel.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to

the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

12. Claims 2, 3, 8, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Todd.

Todd meets all of the limitations of claim 1 as set forth above.

The tolerances and the margins between the lip of the overlay and the flange lip would have been obvious as design or mechanical expedient since those of ordinary skill in the art could readily determine suitable tolerances.

For the overlay to comprise a heat-resistance paint finish, a metal-plated finish, or no finish all would have been obvious as such are well-known in the art and one of ordinary skill could decide which finish is desired.

13. Claims 2, 3, 6, 8, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eikhoff.

Eikhoff meets all of the limitations of claim 1 as set forth above.

The tolerances between the lip of the overlay and the flange lip are design expedients obvious to those of ordinary skill in the art.

To use a metal-plated finish, a heat resistant paint finish, or no finish at all would have been obvious to those of ordinary skill in the art as design expedients as all of these finishes are well-known in the art.

As shown in figure 5, it is obvious that the rim flange and the overlay could accept an industry standard balance weight.

Response to Arguments

14. Applicant's arguments filed August 9, 2002 have been fully considered but they are not persuasive.

Applicants' arguments that the patents to Todd, Eikhoff, and Buerger do not anticipate the claims is not understood since they clearly show the overlays to at least substantially cover the outer lip of the rim flanges, but the outer edges of the overlays do not extend beyond the rim flange lips. In other words, the diameters of the overlays are substantially the same, but not greater than the diameters of the rim flanges.

Applicants argue that the Todd, Eikhoff, and Buerger patents do not recognize the problems associated with a wheel cover which extends beyond the radially outermost edge of the rim. This cannot be true because all of the references show the outermost lips of the covers or overlays as extending up to but not beyond the outermost edge of the wheel rim. It is well-known in the wheel cover art that a cover which extends radially beyond the rim will contact an under-inflated tire, or would contact the tire when the tire contacts a bump or pothole. In either

instance, the wheel cover could be damaged or dislodged from the wheel. This is well-known in the art. Applicants further argue that the references do not provide a suggestion that the covers or overlays have a radially outermost edge aligned with a predetermined margin so as to cover the flange lip of the rim but not extend beyond the edge of the lip flange. Since each of the patents teaches that the cover or overlay extends up to but not beyond the outermost edge of the wheel rim flange, there is no reason to speculate that the covers or overlays can extend beyond the rim flanges, regardless of tolerance variations of the overlay or the wheel rim. It is inherent that each of the covers or overlays would have predetermined dimensions.

The arguments on page 10 suggesting that disclosures of the patents used in the rejections somehow "implicitly allow for the wheel cover to extend beyond the outermost edge of the wheel due to tolerance variations" is not understood and further is blatantly incorrect since none of the references state or imply that the outermost edges of the covers could extend beyond the outermost edge of the wheel rims. Applicant cannot add teachings into the references.

Applicants' characterization of the teachings of the patent to Todd as an "incidental suggestion" in the second paragraph of page 16 of the response filed August 9, 2002, and the statement that such "suggestion" "raises more questions than it answers," and therefore the patent "cannot form the basis of a rejection against Applicants' claims, which according to the requirements of 35 U.S.C. 112, define clear structural differences" implies that the Todd patent is somehow deficient under 35 U.S.C. 112 because its disclosure is unclear or insufficient. This statement is not well-taken by the Examiner because of the suggestions made about the patent.

Applicants should noted that United Sates Patents are presumed to be valid, and their attention is directed to 35 U.S.C. 282. Further, Applicants' statement does not in any way assist in explaining how the claims define over the Todd patent and therefore does not advance the prosecution of the application. More than an "incidental suggestion," Todd clearly teaches that the lip or edge 34 of the fascia extends to the edge of the wheel as stated in lines 35 and 36 of column 3. The drawings clearly show the outer edge of the rim to be covered by the outer periphery of the overlay and further show that the overlay does not extend beyond the rim flange.

The statement bridging pages 9 and 10 that the Examiner's rejections appear to rely exclusively on the drawing figures of the patents used is objected to by the Examiner. This statement is not germane to the issue of the patentability of the claims, and certainly does not help to advance the prosecution of the application. However, for Applicants' benefit, the Examiner has now made reference to relevant passages in each of the patents relied upon in order to specifically point out the subject matter clearly taught in those references.

Further, it is suggested that Applicant become familiar with 37 CFR 1.3. In the future, papers submitted by the instant Applicant which contain offensive comments will be forwarded to the Office of the Director with the request that they be returned to Applicant.

Conclusion

15. Applicant's amendment necessitated the new grounds of rejection presented in this Office action. The amendments to claims 1 and 15 removed certain limitations and necessitated the use of the newly applied references.

Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell D. Stormer whose telephone number is (703) 308-1113.

rds

November 2, 2002

RUSSELL D. STORMER 11/2/02
PRIMARY EXAMINER